UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,963	01/16/2004	Marvin McClinton Smith	04-40003-US	6520

7066 7590 09/30/2005

REED SMITH LLP
2500 ONE LIBERTY PLACE
1650 MARKET STREET
PHILADELPHIA, PA 19103

EXAMINER	
CHEUNG, WILLIAM K	
ART UNIT	**PAPER NUMBER**
1713	

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/758,963	SMITH, MARVIN MCCLINTON	
	Examiner	Art Unit	
	William K. Cheung	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *10-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. In view of applicants' argument regarding the election restriction set forth April 8, 2005, the species election has been withdrawn. However, there are still two groups of invention in the claims that stand restricted for the following reasons.

2. Applicant's affirmed election of Group I invention, claims 1-3, is acknowledged. In view of the similarity of claims 4-9 with claims 1-3, claims 1-9 are group together as Group I, and claims 10-18 has been regrouped to Group II inventions.

I. Claims 1 to 9, drawn to a polymer composition, classified in class 524, subclass 845.

II. Claims 10 to 18, drawn to a process for making a polymer composition, classified in class 524, subclass 845.

Regarding the reasons for the restriction, applicants must recognize that Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make

other and materially different product, such as a polymer composition comprising polyurethane emulsion.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since the claims have been regrouped, the restriction set forth by the examiner is deemed proper and is therefore made Final.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Williams et al. (US 2001/0051265 A1).

The invention of claims 1-3 relates to ***polymer composition*** *comprising subcompositions wherein one or more first subcomposition comprises one or more* ***acrylic emulsions****; one or more second subcomposition comprises one or more* ***ethylene-vinyl chloride emulsion*** *and one or more* ***acrylic emulsions****; and one or more third subcomposition comprises one or more* ***acrylic emulsions***, ***water***, *one or more* ***waxes*** *and one or more* ***styrenated acrylic emulsion***, *wherein the subcompositions are* ***each separately stable within the composition***.

The invention of claim 4 relates to a ***polymer composition*** *comprising subcompositions wherein one or more first subcomposition comprises one or more* ***acrylic emulsions****; one or more second subcomposition comprises one or more*

***acrylic resin**, one or more **acrylic emulsions** and one or more **ethylene-vinyl chloride emulsions**; and one or more third subcomposition comprises one or more **acrylic resin**, one or more **acrylic emulsions**, and **water**, wherein the subcompositions are **each separately stable within the composition**.*

*The invention of claim 5 relates to a **polymer composition** comprising subcompositions wherein one or more first subcomposition comprises one or more **acrylic emulsions**; one or more second subcomposition comprises one or more **ethylene-vinyl chloride emulsions**; and one or more third subcomposition comprises one or more **acrylic emulsions**, water and one or more **waxes**, wherein the subcompositions are **each separately stable within the composition**.*

*The invention of claim 6 relates to a **polymer composition** comprising subcompositions wherein one or more first subcomposition comprises one or more **acrylic emulsions**; one or more second subcomposition comprises one or more **acrylic emulsions** and one or **more vinyl acetate emulsions**; one or more third subcomposition comprises one or more **acrylic emulsions** and one or more **styrenated acrylic emulsion**; and one or more fourth subcomposition comprises one or more **acrylic emulsions**, water, one or more waxes and one or more **styrenated acrylic emulsion**, wherein the subcompositions are **each separately stable within the composition.***

The invention of claim 7 relates to a ***polymer composition*** *comprising subcompositions wherein one or more first subcomposition comprises one or more* ***acrylic emulsions****; one or more second subcomposition comprises one or more* ***acrylic resins****, one or more* ***acrylic emulsions****, and one or more* ***vinyl acetate emulsions****; one or more third subcomposition comprises one or more* ***acrylic resins*** *and one or more* ***acrylic emulsions****; and one or more fourth subcomposition comprises one or more* ***acrylic emulsions****, one or more* ***waxes*** *and one or more* ***styrenated acrylic emulsion****, wherein the subcompositions are* ***each separately stable within the composition****.*

The invention of claim 8 relates to a ***polymer composition*** *comprising subcompositions wherein one or more first subcomposition comprises one or more* ***acrylic emulsions****; one or more second subcomposition comprises one or more* ***acrylic resins*** *and one or more* ***acrylic emulsions****; one or more third subcomposition comprises one or more* ***acrylic emulsions*** *and* ***water****; and one or more fourth subcomposition comprises one or more* ***acrylic emulsion****, one or more* ***wax*** *and one or more* ***styrenated acrylic emulsion****, wherein the subcompositions are* ***each separately stable within the composition****.*

The invention of claim 9 relates to a ***polymer composition*** *comprising subcompositions wherein one or more first subcomposition comprises one or more* ***acrylic emulsion****,* ***water****, one or more* ***acrylic colloidal dispersion****, and a* ***glycol****; one*

or more second subcomposition comprises one or more ***acrylic emulsion****; and one or more third subcomposition comprises one or more* ***wax*** *and one or more* ***acrylic emulsion****, wherein the subcompositions are* ***each separately stable within the composition****.*

Williams et al. (page 4-8, paragraph 0051-0110) disclose an adhesive layer that is prepared by materials that are in the emulsion or latex forms. Williams et al. (page 4, paragraph 0054) disclose ingredients including wax, ethylene chloride copolymer acrylic copolymer, and styrenated acrylic copolymers. Regarding the claimed "the subcompositions are each separately stable within the composition", the examiner believes that it is inherently possessed in Williams et al. because the compositions of Williams et al. involves the addition of various ingredients in the emulsion form. If the emulsions are not each separately stable within the disclosed composition, the composition would have coagulated and became un-usable. Because Williams et al. in the disclosure clearly indicate the success of preparing a heat sealing material that are in particle size in the range of from about 2 to about 10 microns, the examiner has a reasonable basis to believe that the claimed "the subcompositions are each separately stable within the composition" is inherently possessed in Williams et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William K. Cheung

Primary Examiner

September 23, 2005

WILLIAM K. CHEUNG
PRIMARY EXAMINER